

**Appl. No.** : **10/648,686**  
**Filed** : **August 25, 2003**

**AMENDMENTS TO THE DRAWINGS**

Please insert the enclosed New Sheet illustrating FIG. 6C as sheet five of five.

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### REMARKS

Claims 1 and 4 have been amended to recite "wherein said extension angle is defined by a portion of said second axis starting from the intersection of said second and third axes and extending toward the intersection of the first and second axes, and a portion of said third axis starting from the intersection of said second and third axes and extending toward the razor head, wherein the extension angle faces the front of the razor." Support for these amendments can be found throughout the specification as filed, for example, paragraph [0029] and Figure 6. Similarly, Claims 1 and 4 are amended to define the contour angle "wherein said contour angle is defined by a portion of said first axis starting from the intersection of said first and second axes and extending toward the end of said razor handle portion located on said lower handle portion, and a portion of said second axis starting from the intersection of said first and second axes and extending toward the intersection of said second and third axes, wherein the contour angle faces the front of the razor." Support for these amendments can be found throughout the specification as filed, for example, paragraph [0028] and Figure 6.

Applicant has added new claims 38-40. Support for these amendments can be found throughout the specification as filed, for example, Figure 2.

Claims 1-8, 10-12, 15, 21-24, 27-28 and 33-40 are presented for examination. Applicant responds below to the specific rejections raised by the PTO in the Office Action sent electronically April 18, 2007. For the reasons set forth below, the Applicant respectfully traverses.

#### **Objection to the Drawings under 37 C.F.R. 1.83(a)**

The PTO has objected to the drawings as not showing an extension angle that is less than or equal to ninety degrees. While the Examiner states that, "[i]t is clear from Figure 6A that a complimentary angle to angle B is less than ninety degrees. To overcome this rejection applicant must add a reference numeral to the specification and to Figure 6A, pointing to angle B's complimentary angle that faces the front of the razor," Applicant notes that as defined in the pending claims, the complimentary angle of angle B is not an extension angle. Applicant has submitted a New Drawing Sheet, which includes FIG. 6C showing an extension angle B that is

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less than or equal to ninety degrees. Applicant therefore requests that the Examiner withdraw the rejection to the drawings.

**Rejection under 35 U.S.C. § 112, second paragraph**

Claims 1-8, 21-22, 27-28, and 33-37 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, claims 1 and 4 are rejected for reciting the phrases “wherein said extension angle is defined by line segments extending from the intersection of said second and third axes along portions of said second and third axes that lie in said middle and upper longitudinal portions of said handle” and “wherein said contour angle is defined by line segments extending from the intersection of said first and second axes along portions of said first and second axes that lie in said lower and middle longitudinal portions of said handle.” The Examiner states that it is unclear if the “line segments” represent the same thing as the axes that form the angle. The Examiner states that, as written, the axes form the intersection but then the line segments extend from the intersection and define the angle. The Examiner further states that in such a case, the line segments could define any angle as long as the line segments extend along portions of the axes.

The test for definiteness is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

While Applicant disagrees with the Examiner’s rejection, in the interest of advancing prosecution, Applicant has amended claims 1 and 4 to clarify which angles are the extension and contour angles as claimed. Claims 1 and 4 now recite “wherein said extension angle is defined by a portion of said second axis starting from the intersection of said second and third axes and extending toward the intersection of the first and second axes, and a portion of said third axis starting from the intersection of said second and third axes and extending toward the razor head, wherein the extension angle faces the front of the razor,” and “wherein said contour angle is defined by a portion of said first axis starting from the intersection of said first and second axes and extending toward the end of said razor handle portion located on said lower handle portion, and a portion of said second axis starting from the intersection of said first and second axes and extending toward the intersection of said second and third axes, wherein the contour angle faces

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the front of the razor.”

“Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.” *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004) (emphasis added). Claims 1 and 4 are not “insolubly ambiguous without discernable meaning,” since a reasonable attempt to construe the claims would lead one of skill in the art to understand what is being claimed. Applicant therefore requests that the Examiner reconsider and withdraw the rejection of Claims 1-8, 21-22, 27-28, and 33-37 under 35 U.S.C. § 112, second paragraph, as being indefinite.

#### **Rejection under 35 U.S.C. §102(b) – Anticipation**

The PTO has rejected claims 1, 4, 7, 8, 21, 27, and 37 under 35 U.S.C. §102(b) as being anticipated by Heller (4,700,477) as illustrated in Appendix A of the Office Action. Applicant respectfully traverses.

##### **Claims 1, 7, 8, and 21**

In rejecting Claim 1, the PTO stated that Heller discloses the same invention, including second and third axes that “form a fixed extension angle that is 90° (104),” referring to Appendix A for the examiner added reference numerals. *Office Action* at 4.

Independent Claim 1 recites “wherein said second and third axes intersect at a single point and form a fixed extension angle that is less than or equal to ninety degrees; wherein said extension angle is defined by a portion of said second axis starting from the intersection of said second and third axes and extending toward the intersection of the first and second axes, and a portion of said third axis starting from the intersection of said second and third axes and extending toward the razor head, wherein the extension angle faces the front of the razor.”

Applicant does not concede that Heller discloses a lower, middle, and upper portion of a handle extending along longitudinal axes as labeled by the PTO in Appendixes A and B. However, even if one assumes that Heller discloses a lower, middle, and upper handle portion with longitudinal axes as labeled by the PTO, the extension angle of Heller as identified by the Examiner in Appendix A by reference numeral 104 is greater than 90 degrees, as is shown in Figure 1 below.

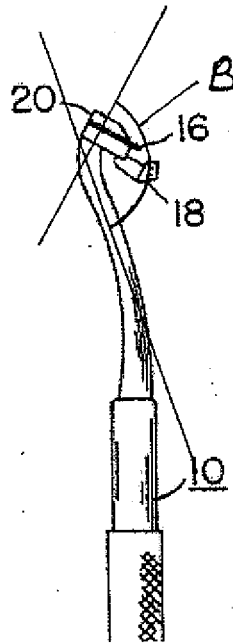


Figure 1

In response to Applicant's argument, the PTO states "In regards to Heller not disclosing an extension angle facing the front of the razor being less than or equal to 90 degrees, claim 1 does not disclose the locations of the second and third axes. All claim 1 discloses is that a middle portion extends along a second axis and the upper portion extends along a third axis. As long as a portion of the middle or upper parts extends along the second or third axes they will anticipate the claim. Therefore, the middle or upper parts extend along re-drawn axes as shown in Appendix A." *Office Action* at 11. Applicant believes that the Examiner intended to refer to re-drawn axes of Appedix B, not Appendix A as stated.

Applicant respectfully disagrees with the PTO's assertion that Claim 1 does not disclose the locations of the second and third axes. Because the claims are part of "a fully integrated written instrument," the claims "must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 978-79 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996). "The specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1581 (Fed. Cir. 1996); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (same).

The specification discloses at paragraph [0028] that "[t]he top longitudinal portion 36

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extends generally along a third longitudinal axis 37.” Figures 6A-6C clearly illustrate the location of top longitudinal portion 36 and third longitudinal axis 37. Claim 1 recites an upper longitudinal portion that “extends along a third axis.” Thus, as used in Claim 1, when read *in view of the specification*, “extends along a third axis” clearly defines the location of the upper longitudinal portion as extending along a third axis, and not merely having some portion of the axis lie within the upper portion as asserted by the Examiner.

Claim terms are given their ordinary meaning unless otherwise indicated in the specification. MPEP § 2111.01 (“[W]ords of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification.”); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372 (Fed. Cir. 2004) (stating that ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say). Clearly, the term “extends along” in “said middle longitudinal portion extends along a second axis” in Claim 1 does not cover the PTO’s interpretation in Appendix B. Thus, it is incorrect to state that upper portion 100 “extends along” re-drawn axis A as shown in Appendix B. Clearly, to the extent that there even is an “upper longitudinal portion” of Heller, it does not “extend along” re-drawn axis A.

In arguing that “[a]s long as a portion of the middle or upper parts extends along the second or third axes they will anticipate the claim,” the PTO is impermissibly placing its own definition of “extends along” on Claim 1. The PTO’s incorrect definition appears to replace “extends along” with “touches in any way.” It is only with this new and unfounded definition of “extends along” that the PTO can argue that “the middle or upper parts extend along *re-drawn axes* as shown in Appendix [B].” *Office Action* at 11 (emphasis added). It is impermissible for the PTO to “redraw” the second and third axes in any manner it wishes, because Claim 1, read in view of the specification, *does* define the location of the second and third axes relative to the middle and upper longitudinal portions and “extending along” *does not* mean “touches in any way.” Thus, the axis the PTO has labeled “A” on the Heller device in Appendix B, for example, is impermissibly and arbitrarily re-drawn to create an extension angle, labeled “AB,” that is 90 degrees. To the extent there is an upper longitudinal portion in the Heller device, it does not *extend along* this redrawn third axis “A,” as that term is used in Claim 1, read in light of the specification.

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Therefore, to the extent that Heller may disclose an extension angle as defined in Claim 1, a point that Applicant does not concede, the extension angle of Heller is not less than or equal to 90 degrees, as recited in Claim 1. Thus, Heller does not anticipate Claim 1 or any claim which depends therefrom. Therefore, Applicant respectfully requests that, for at least this reason, the PTO reconsider and withdraw the rejection of Claims 1, 7, 8, and 21 as anticipated by Heller.

Claims 1, 4, 7, 8, 21, 27, and 37

In rejecting Claims 1 and 4, the PTO stated that Heller discloses the same invention, including first and second axes that "intersect at a single point (BC) and form a fixed contour angle that is less than 180° (105)," referring to axes and reference numerals drawn by the Examiner in Appendix B. *Office Action* at 4, 5. The PTO also states:

[A]pplicant provides a picture showing that angle C (105 in the Office Action) is larger than 180 degrees. However, as drawn, angle C is a combination of 3 of the 4 angles created by the intersection. Using Appendix C, shows that using the same way of measuring also creates an angle larger than 180 degrees in applicant's apparatus (C'). *Office Action* at 11.

However, the contour angle recited in Claims 1 and 4 is not greater than 180 degrees. As recited in Claims 1 and 4, the contour angle is the angle defined by a portion of the first axis starting from the intersection of the first and second axes and extending toward the end of the razor handle portion located on the lower handle portion, and a portion of the second axis starting from the intersection of the first and second axes and extending toward the intersection of the second and third axes, wherein the contour angle faces the front of the razor. Clearly, the contour angle as recited in Claims 1 and 4, illustrated as angle C in Figure 2 below, is less than 180 degrees:

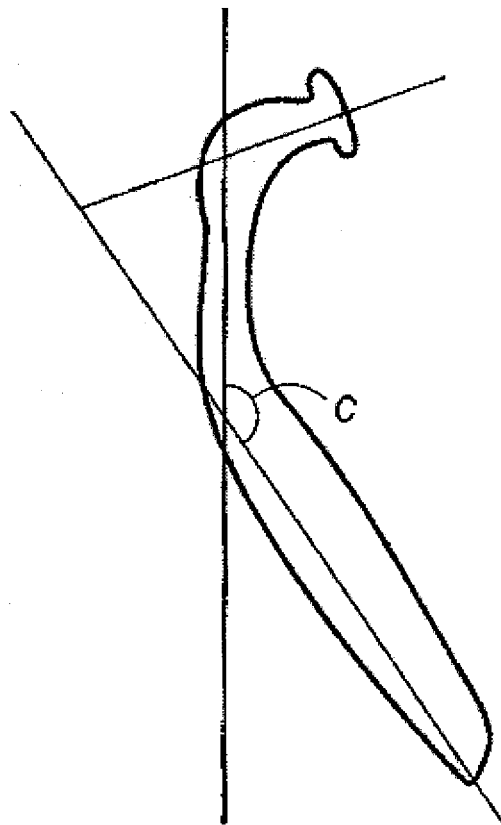


Figure 2

Applicant does not concede that Heller discloses a lower, middle, and upper portion of a handle extending along longitudinal axes as labeled by the PTO in Appendix B. However, even if one assumes that Heller discloses a lower, middle, and upper handle portion with longitudinal axes as labeled by the PTO, the contour angle of Heller when properly identified is greater than 180 degrees, as illustrated in Figure 3 below:



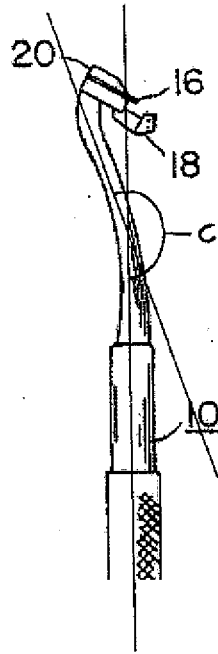


Figure 3

Because the contour angle of Heller based on the axes identified by the PTO is not less than 180 degrees as recited in claims 1 and 4, Heller does not anticipate either of these claims or any claim which depends therefrom. Therefore, Applicant respectfully requests that, for at least this reason, the PTO reconsider and withdraw the rejection of Claims 1, 4, 7, 8, 21, 27, and 37.

#### **Rejection under 35 U.S.C. §103(a) – Obviousness**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some motivation to modify the reference or combine reference teachings. See *MPEP* § 2143.01 (“A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art’ at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)) (emphasis added); *Takeda Chemical Indus., Ltd. v. Alphapharm Pty., Ltd.*, No. 06-1329, 2007 WL 1839698, at \*5 (Fed. Cir. June 28, 2007) (“[T]he [Supreme] Court acknowledged the importance of identifying ‘a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements

in the way the claimed new invention does' in an obviousness determination." (citing *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731 (2007))). Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all the claim limitations.

Claims 2, 3, 33, and 34

The PTO rejects Claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Heller in view of Heinrich (2,139,680). The PTO states that Heller discloses the invention but fails to disclose a disposable head portion or a head portion that is pivotally mounted on the handle portion, which Heinrich discloses. Applicant respectfully disagrees.

Claims 2 and 3 depend from Claim 1. For the reasons discussed above with respect to the §102(b) anticipation rejection of Claim 1, Heller does not disclose the invention of Claim 1. Specifically, without conceding that Heller discloses a lower, middle, and upper portion of a handle extending along longitudinal axes as labeled by the PTO in Appendices A and B, the extension angle identified by the PTO is not less than or equal to 90 degrees, nor is the contour angle based on the axes identified by the PTO less than 180 degrees. Heinrich does not supply any of these missing elements.

In addition, Heinrich does not disclose a disposable head as recited in Claim 2. With regard to Claim 2, the PTO argues "When the head is apart from the shaft it is old and well known that one could throw it away making it capable of being disposable." However, to the extent Heinrich discloses a head portion, the Heinrich device does not include a disposable *head portion*, only a removable *razor blade*. Nothing in Heinrich teaches that either the blade holder 21 or head portion 10 are disposable. Specifically, Heinrich states "10 designates a plate, preferably formed of metal, which serves as the frame or support for the blade" (col. 1, lines 38-40) and "[f]ormed integral with the underside of plate 10 . . . is a stud 12 in which is formed a threaded recess for the accommodation of the threaded stem 13 of a handle 14" (col. 1, lines 45-49). Plate 10, upon which razor blade 17 is held against movement by combined guard and blade holder 21, is a machined part, comprising a threaded recess to receive a threaded stem 13, upwardly projecting studs 15 to receive notches 17 on the razor blade, teeth 11 that function as guards, and stud 16 to receive aperture 20 on the razor blade. Clearly, the highly-machined plate

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10 is not intended to be disposed of along with the razor blade when the blade is worn and requires replacement. According to the PTO's argument that Heinrich comprises a disposable head portion because it can be thrown away and is therefore "capable of being disposable," the entire Heinrich device, with the assembled blade holder 21, blade 17, plate 10, and handle 14 is also "disposable" because it can be thrown away. The PTO's argument applies to everything, from luxury cars to skyscrapers, because they are "capable of being disposable." Were the PTO's definition of "disposable" adopted, the distinction between "disposable" and "non-disposable" items would not exist. Thus, the highly-machined head portion of the Heinrich device is not "disposable" in any ordinary sense of the word. Heinrich only discloses disposable *razor blades* situated on a plate that is not disposed of or replaced when a new razor blade is required.

Nor does Heinrich disclose a pivotally mounted head portion as recited in Claim 3. With regard to Claim 3, the PTO states: "In order for the head of Heinrich to be mounted onto the body, it must be rotated or pivoted about shaft 13 (like a screw), making it pivotally mounted to the handle." However, the head portion of Heinrich is threaded onto the handle, it is not pivotally mounted. Heinrich states "the studs 15 in the notches 19 and the stud 16 in the aperture 20, firmly holds the blade against any lateral or twisting movement while positioned upon the holder," (col. 2, lines 10-14) and "the blade is held against movement in all directions upon the plate 10" (col. 2, lines 44-45). Finally, Heinrich also states "the parts of the razor are firmly retained in assembled relation" (col. 2, lines 52-53).

In contrast, the specification states in paragraph [0030]: "In some embodiments, the shaving head 38 is mounted via a pivoting joint (not shown) such that the angle of the shaving head 38 can vary with respect to the rest of the razor 30 during shaving allowing its use in various applications. Any pivot joint capable of rotatably connecting the shaving head 38 to the upper longitudinal portion 36 can be used." Thus, after reading Claim 3 in view of the specification, it is clear that the angle of the pivotally-mounted head portion relative to the handle portion can vary *when the personal styling razor is in use*, as it can pivot around its pivoting joint. However, the head portion of Heinrich, to the extent it discloses one, is completely stationary relative to the handle *when the device is in use*. Specifically, blade 17 "is held against movement in all directions upon the plate 10," and plate 10, once screwed in place into handle 14, does not move relative to handle 14 when the device is in use. The act of rotating plate 10 to

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screw it into handle 14 occurs when the Heinrich device is assembled, and must be complete before the Heinrich device can be used as a razor. In fact, Heinrich specifically teaches away from the inclusion of any pivoting parts when the device is in use, stating: "Thus, the parts of the razor are firmly retained in assembled relation and said razor may be conveniently used for cutting hairs from the nostrils and ears." (col. 2, lines 52-55).

For the reasons stated above, the combination of Heller and Heinrich fails to disclose or suggest each and every element of Claims 2 and 3, and the PTO has failed to establish a *prima facie* case of obviousness. Applicant therefore respectfully requests that, for at least these reasons, the PTO reconsider and withdraw the rejection of Claims 2 and 3 as obvious over Heller in light of Heinrich.

Claims 5, 6, 35, and 36

The PTO rejects Claims 5, 6, 35, and 36 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Heller in view of Carreker (4,461,078). The PTO states that Heller discloses the invention, but fails to disclose a length of the upper longitudinal portion that is greater than the width of the head portion and a second razor blade. The PTO argues that Carreker teaches that it is old and well known for miniature grooming shaving heads to incorporate the missing elements. Applicant respectfully disagrees.

Claims 5, 6, 35, and 36 depend from Claims 1 and 4. For the reasons discussed above with respect to the §102(b) anticipation rejection of Claims 1 and 4, Heller does not disclose the invention of Claims 1 and 4. Specifically, with regard to Claim 1, without conceding that Heller discloses a lower, middle, and upper portion of a handle extending along longitudinal axes as labeled by the PTO in Appendix A, the extension angle identified by the PTO is not less than or equal to 90 degrees. With regard to Claims 1 and 4, Heller does not disclose a contour angle that is less than 180 degrees. Carreker does not supply any of these missing elements.

In addition, in response to Applicant's argument that Carreker does not disclose a device where "a length of said upper longitudinal portion is greater than said width of said head portion," the PTO states "Carreker clearly shows the upper portion is greater than the width of the head portion." Applicant respectfully asserts that this statement is not responsive to Applicant's argument, because the PTO fails to identify what it regards to be the upper

longitudinal portion in the Carreker device. Specifically, the PTO has not identified an upper longitudinal portion that "extends along a third axis" wherein a head portion is "attached to said upper longitudinal portion," as recited in Claims 1 and 4. To the extent that Carreker does disclose an "upper longitudinal portion" with a head portion "attached to said upper longitudinal portion," it would have to be the curved portion A of the handle 12 as shown in Carreker Figure 3. As a comparison of Carreker Figures 2 and 3 make clear, the length of the curved portion A of handle 12 is not greater than the width of head 20, as shown in Figure 4 below:

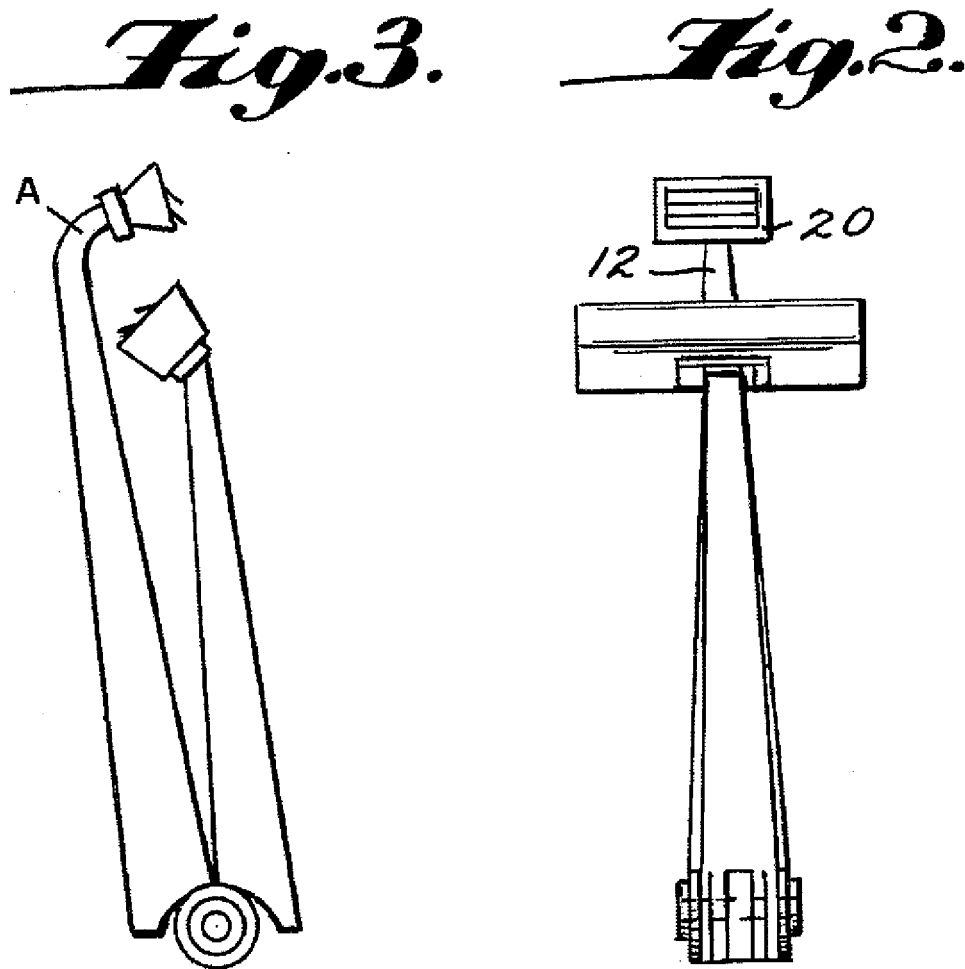


Figure 4

Finally, Applicant cannot conceive of any reason for one of skill in the art to modify the handle disclosed by Heller by placing the razor head and curved portion of the Carraker handle 12 thereon. The PTO has not pointed to any portion of the cited references or the knowledge of one of skill in the art as providing a reason to combine the devices of Heller and Carraker to

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derive the claimed device. Instead, the PTO is impermissibly using the Applicant's disclosure as a hindsight guide for combining the references.

Because the combination of Heller and Carraker fails to disclose or suggest each and every element of Claims 5, 6, 35 and 36 and the PTO has failed to provide a reason to modify the cited references, the PTO has failed to establish a *prima facie* case of obviousness. Applicant therefore respectfully requests that, for at least these reasons, the PTO reconsider and withdraw the rejection of Claims 5, 6, 35, and 36 as obvious over Heller in light of Carraker.

Claims 22 and 28

The PTO rejects Claims 22 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Heller. The PTO states that Heller discloses the invention but fails to disclose a head portion that is equal to or less than 1/8 inch wide. However, the PTO argues that Heller's disclosure of a width of approximately 3/16 - 1/4 inch is near 1/8, and it would have been obvious for one of skill in the art to modify Heller to make a head portion equal to or less than 1/8 inch. The PTO also states "Applicant has not disclosed that the specific head portion width provides an advantage, is used for a particular purpose, or solves a stated problem." Applicant respectfully disagrees.

The specification explains at paragraph [0031]: "By combining the extremely small shaving head 38 of some embodiments with the maximized precision control allowed by the handle 31, a razor 30 can now be manufactured that can be used to shave hair from areas not previously possible. While previous razors may have been somewhat smaller than other previous razors, none of those examples [ ] are used for shaving hair as embodiments described herein allow. . . . Stylists previously broke straight razor blades to create shaving blades of the proper geometry to allow them to shave the styles requested by customers. This practice is unsafe for both the stylist and the customer. The razor 30 of the embodiments described herein allows safer shaving of such designs." Thus, the personal styling razor disclosed in Claims 22 and 28 provides the advantage of an extremely small razor head configured to permit shaving hair, that is used for the particular purpose of shaving precise and fine details in areas that heretofore could not be safely shaved by a razor. The personal styling razor of Claims 22 and 28 also solve an

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additional problem: the unsafe practice of breaking straight razor blades to create shaving blades capable of precision shaving of fine details.

In addition, Claims 22 and 28 depend from Claims 1 and 4. For the reasons discussed above with respect to the §102(b) anticipation rejection of Claims 1 and 4, Heller does not disclose the invention of Claims 1 or 4. Specifically, with regard to Claim 1, without conceding that Heller discloses a lower, middle, and upper portion of a handle extending along longitudinal axes as labeled by the PTO in Appendix A, the extension angle identified by the PTO is not less than or equal to 90 degrees. With regard to Claims 1 and 4, Heller does not disclose a contour angle that is less than 180 degrees. Thus, even if one of skill in the art would have a reason to modify the head of Heller to be equal to or less than 1/8 inch, a point Applicant does not concede, the modified device of Heller fails to disclose or suggest each and every element of Claims 22 and 28, and the PTO has failed to establish a *prima facie* case of obviousness. Applicant therefore respectfully requests that, for at least these reasons, the PTO reconsider and withdraw the rejection of Claims 22 and 28 as obvious over Heller.

#### Claims 10 and 23

The PTO rejects Claims 10 and 23 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Heller in view of the Lamb design patent (Des. 169,147). The PTO states that Heller discloses the invention, but fails to disclose an ergonomically shaped handle or a handle portion that has a front perspective that is substantially hour-glass in shape. The PTO argues that Lamb teaches that it is old and well known in the art of razor handles to incorporate an ergonomically shaped handle and the handle portion has a front perspective that is substantially hour-glass shaped. Applicant respectfully disagrees.

First, the PTO argues that "Lamb clearly teaches it is old and well known for razors to incorporate ergonomic handles. Lamb is being used to teach shape not size. It would be obvious to one of ordinary skill in the art to provide Heller with an appropriate sized handle with an ergonomic shape." However, regardless of whether Lamb is used to teach shape or size, the PTO has not provided any reason for one of skill in the art to combine the handle of Lamb with the head portion of Heller. Further, the PTO statement does not respond to Applicant's previous argument that Heller actually teaches away from the combination. Heller states that "the

principle prior art in the field of developing an eyebrow trimmer has been the man's safety razor," but one of the problems with using a standard safety razor to trim eyebrows is that the large blades prevent accurate trimming. *See Heller* at col. 1, lines 29-36.

Second, the combination of the small head and razor of Heller on the handle of Lamb would render the device of Heller inoperable for its intended purpose of trimming eyebrows because the large bulbous end of the Lamb handle would obscure the small head of Heller, and the user would not be able to accurately trim the eyebrows. MPEP § 2143.01 ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.").

Thus, because Heller has identified the prior art of standard safety razors as inadequate for solving the problem of trimming eyebrows, one of skill in the art following the teachings of Heller would not look to a standard safety razor handle like Lamb to modify the device of Heller.

Because there is no reason to modify the device of Heller by combining the Heller and Lamb references, and the combination would render Heller unsatisfactory for its intended purpose, the PTO has failed to establish a *prima facie* case of obviousness. Applicant therefore respectfully requests that, for at least these reasons, the PTO reconsider and withdraw the rejection of Claims 10 and 23 as obvious over Heller in light of Lamb.

#### Claims 11 and 12

The PTO rejects Claims 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Heller in view of Lamb and further in view of Heinrich. The PTO argues that Heller and Lamb disclose the invention of Claim 10, but fail to disclose a replaceable head portion and a head portion pivotally mounted on the handle portion.

First, Applicant respectfully disagrees that Heinrich discloses a replaceable or pivotally mounted head portion for the reasons discussed above with respect to Claims 2, 3, 33, and 34.

In addition, Applicant notes that Claims 11 and 12 depend from Claim 10. Applicant asserts that the PTO has failed to establish a *prima facie* case of obviousness or that Heller and Lamb disclose the invention of Claim 10, for at least the reasons discussed above: (1) the PTO has not provided any reason to combine the handle of Lamb with the head portion of Heller; and (2) the combination of Heller and Lamb would render Heller unsatisfactory for its intended



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purpose, so the PTO has not established any expectation of success, much less a reasonable expectation of success. Thus, even if Heinrich disclosed a replaceable head portion and a head portion pivotally mounted on the handle portion, a point Applicant does not concede, the addition of these elements to the combination of Heller and Lamb do not cure the combination's deficiencies noted above.

Applicant therefore respectfully requests that, for at least these reasons, the PTO reconsider and withdraw the rejection of Claims 11 and 12 as obvious over Heller in light of Lamb and Heinrich.

Claim 15

The PTO rejects Claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Heller in view of Lamb and Carreker. The PTO argues that Heller and Lamb disclose the invention of Claim 10, but fail to disclose a second razor blade, which Carreker teaches is old and well known. Applicant respectfully disagrees.

Claim 15 depends from Claim 10. Applicant asserts that the PTO has failed to establish a *prima facie* case of obviousness or that Heller and Lamb disclose the invention of Claim 10, for at least the reasons discussed above: (1) the PTO has not provided any reason to combine the handle of Lamb with the head portion of Heller; and (2) the combination of Heller and Lamb would render Heller unsatisfactory for its intended purpose, so the PTO has not established any expectation of success, much less a reasonable expectation of success. Thus, even if Carreker disclosed a second razor blade, the addition of this element to the combination of Heller and Lamb does nothing to cure the combination's deficiencies noted above.

Applicant therefore respectfully requests that, for at least these reasons, the PTO reconsider and withdraw the rejection of Claim 15 as obvious over Heller in light of Lamb and Carreker.

Claim 24

The PTO rejects Claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Heller in view of Lamb. The PTO states that Heller and Lamb disclose the invention but fail to disclose a

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head portion that is equal to or less than 1/8 inch wide, but that such modification of Heller would have been obvious. Applicant respectfully disagrees.

As discussed above with respect to claims 22 and 28, the PTO argues that Heller's disclosure of a width of approximately 3/16 - 1/4 inch is near 1/8, and it would have been obvious for one of skill in the art to modify Heller to make a head portion equal to or less than 1/8 inch. The PTO also states "Applicant has not disclosed that the specific head portion width provides an advantage, is used for a particular purpose, or solves a stated problem." Applicant respectfully disagrees.

The specification explains at paragraph [0031]: "By combining the extremely small shaving head 38 of some embodiments with the maximized precision control allowed by the handle 31, a razor 30 can now be manufactured that can be used to shave hair from areas not previously possible. While previous razors may have been somewhat smaller than other previous razors, none of those examples [ ] are used for shaving hair as embodiments described herein allow. . . . Stylists previously broke straight razor blades to create shaving blades of the proper geometry to allow them to shave the styles requested by customers. This practice is unsafe for both the stylist and the customer. The razor 30 of the embodiments described herein allows safer shaving of such designs." Thus, the personal styling razor disclosed in Claims 22 and 28 provides the advantage of an extremely small razor head configured to permit shaving hair, that is used for the particular purpose of shaving precise and fine details in areas that heretofore could not be safely shaved by a razor. The personal styling razor of Claims 22 and 28 also solve an additional problem: the unsafe practice of breaking straight razor blades to create shaving blades capable of precision shaving of fine details. Absent Applicant's disclosure, the PTO has not provided any reason for one of skill in the art to modify the device of Heller to provide the missing element of a head portion that is equal to or less than 1/8 inch wide.

In addition, Claim 24 depends from Claim 10. Applicant asserts that the PTO has failed to establish a *prima facie* case of obviousness or that Heller and Lamb disclose the invention of Claim 10, for at least the reasons discussed above: (1) the PTO has not provided any reason to combine the handle of Lamb with the head portion of Heller; and (2) the combination of Heller and Lamb would render Heller unsatisfactory for its intended purpose, so the PTO has not established any expectation of success, much less a reasonable expectation of success. Thus,

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even if one of skill in the art would have had a reason to modify the head of Heller to be equal to or less than 1/8 inch, a point Applicant does not concede, this modification of Heller does nothing to cure the deficiencies in the Heller and Lamb combination noted above.

Applicant therefore respectfully requests that, for at least these reasons, the PTO reconsider and withdraw the rejection of Claim 24 as obvious over Heller and Lamb.

### CONCLUSION

In view of the above, Applicant respectfully maintains that Claims 1-8, 10-12, 15, 21-24, 27-28 and 33-40 are patentable and request that they be passed to issue. Applicant invites the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 7/18/07

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